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Franz Josef Brocker

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NOVAK DRUCE DELUCA + QUIGG LLP

1300 EYE STREET NW

SUITE 1000 WEST TOWER

WASHINGTON, DC 20005

EXAMINER

DANG, THUAN D

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANZ JOSEF BROCKER, MATHIAS HAAKE,
GERD KAIBEL, GERD ROHRBACHER,
EKKEHARD SCHWAB, and MANFRED STROEZEL

Appeal 2008-1715
Application 09/629,482
Technology Center 1700

Decided: March 14, 2008

Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and
KAREN M. HASTINGS, *Administrative Patent Judges*.
HASTINGS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This is an appeal from the final rejection of claims 11-16.

The Examiner's Answer includes a rejection of all the appealed claims, i.e., claims 11-16, under 35 U.S.C. § 103 over Arganbright.

Our review of the application leads us to conclude that this appeal is not in condition for a decision at this time. Therefore, we remand the application to the Examiner to consider the following issues and to take appropriate action.

Claim 11 requires that the process be carried out under “isothermal conditions”. In the Answer, the Examiner stated that the process of Arganbright was “in an isothermal reactor” (Ans. 4). However, none of the specific portions of the reference relied upon by the Examiner explicitly discuss whether the reactor is isothermal, nor whether the reaction is carried out under isothermal conditions. Appellants responded with a Reply Brief in which they argue for the first time in the appeal record that the process in Arganbright is not isothermal (Reply Br. 2-3). The Examiner entered this Reply Brief and stated that it was considered (Reply Brief Noted, Oct. 17, 2007), however, the Examiner did not make of record any response to Appellants’ new argument.

Accordingly, this Application is remanded to the Examiner to elicit a response to Appellants’ new argument in the Reply Brief that Arganbright does not teach a process for carrying out a reaction under isothermal conditions.

As pointed out by Appellants, Arganbright appears to indicate that the distillation column is not an isothermal reactor (col. 8, ll. 34-39). We note that Arganbright also describes that “[t]his method of operation is more fully described in commonly owned U.S. patent application Ser. No. 07/328,487, which is incorporated herein by reference” (Col. 9, ll. 23-26). Smith, Jr. (US 5,204,064, a continuation of application 07/328,487) shows in Table I that temperatures vary along the height of the column, from as much as 315°F at the bottom, 185°F at the catalyst zone, and 165°F at the overhead (col. 5, ll. 1-15).

We further note that Arganbright describes, in an alternative embodiment, that “mid internal *reflux* from runs using the Omega sieve were collected and combined and fed over a Y-82 sieve catalyst...in a 3/8 inch *isothermal* reactor (as represented by FIG. 2).” (Emphasis provided; col. 9, ll. 55-60). This appears to be the only explicit description in the reference of an *isothermal* reactor, yet the Examiner did not refer to this passage of Arganbright in the Answer. If the Examiner is relying on the Fig. 2 embodiment, this reliance must be expressed in the record along with a discussion of how the claims are rendered unpatentable by this specific embodiment.

We note that the Examiner referenced the vapor phase of the distillation column in an attempt to establish that there must be a dispersed gas of propylene in the liquid as required by the appealed claims (Ans. 4; Arganbright col. 8, ll. 52-55). As shown in Fig. 2, a catalyst bed reactor 7 is located outside the distillation column. The reflux is described as a liquid phase separate from a vapor phase (e.g., col. 3, ll. 55 of Arganbright). If relying on the Fig. 2 embodiment, the Examiner must clarify how the dispersion requirement of the claims is rendered unpatentable by this embodiment.

Specifically, the Examiner must interpret, as to its meaning and scope, the claimed phrase “passing the generated reaction fluid, *without substantial change in the degree of dispersion of said reaction fluid*, through a reactor...” (emphasis provided). Then, the Examiner must determine whether or not “passing the generated reaction fluid...” as claimed is

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rendered obvious by the *reflux* (i.e., the liquid phase) collected and combined and fed through the reactor 7 located outside of the distillation column of Arganbright.

In order to fully develop the issues on appeal, the Examiner must respond to Appellants' above noted argument and address the concerns discussed above. Accordingly, we remand the application to the Examiner, via the Office of a Director of Technology Center 1700, for providing the record with a response to Appellants' new argument presented in the Reply Brief or for other action not inconsistent with the above discussion.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REMANDED

tf/ljs

NOVAK DRUCE DELUCA & QUIGG LLP
1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON, DC 20005